

REMARKS

Status of the Claims

1-6, 8-10, 12, 14-50 and 55-70 are pending herein, claims 7, 11, 13 and 51-54 having been previously canceled.

Claims 34-50 have been withdrawn by the Examiner.

Claims 2-6, 8-10, 12, 22-33 and 55-70 are allowed.

Claims 1 and 14-21 are presently rejected.

Prior Claim rejection under 35 USC § 102(b)

Withdrawal of the prior rejection under 35 USC §102(b)) is noted with appreciation.

Prior Claim rejection under 35 USC § 112, first paragraph

Withdrawal of the prior rejection under 35 USC §112, first paragraph is noted with appreciation.

Current Claim rejection under 35 USC § 112, second paragraph

Claims 1 and 14-21 are presently rejected under 35 USC §112, second paragraph as allegedly being indefinite. More particularly, the Office alleges that the metes and bounds of claims 1 and 14 are indefinite.

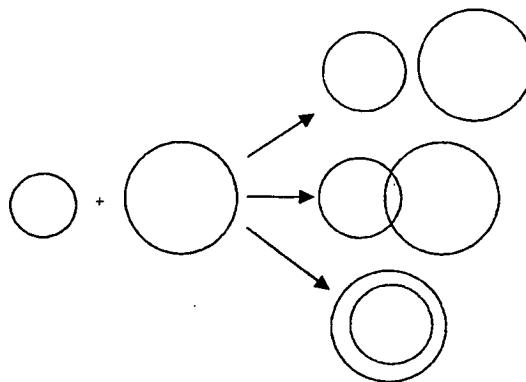
With regard to claim 1, the Office argues that members of the Markush Group of claim 1 overlap in that all may be pharmaceuticals, an adjuvant is an immunomodulator, several members may be antigens, transcription or translation mediators may be enzymes, and several members may be polypeptides.

Similarly, with regard to claim 14, the Office appears to be concerned with overlap between members of the Markush Group, arguing that muramyl peptides are bacterial wall components.

These rejections are respectfully traversed.

The requirements for Markush claim practice are set forth in MPEP 803.02, which does not give any indication that overlap between members of a Markush group is prohibited. (To the extent the Examiner is aware of any legal precedent prohibiting overlap between members of a Markush group, he is respectfully requested to cite such precedent.)

The metes and bounds of each of the members within the Markush groups of claims 1 and 14 clear. Thus, the overall scope of each Markush group is clear. This can be shown geometrically



by the following Venn diagrams: . Where the area of each Markush member is well-defined, the area covered by the combination of these members is also well-defined. This is true whether the overlap is nonexistent (top), partial (middle) or total (bottom). Thus, the fact the members of these Markush groups may overlap in scope does not render the scope of these claims indefinite.

Reconsideration and withdrawal of the rejection of claims 1 and 14-21 under 35 USC §112, second paragraph are respectfully requested.

Allowed Claims

The allowance of claims 2-6, 8-10, 12, 22-33 and 55-70 is noted with appreciation.

CONCLUSION

It is respectfully submitted that all claims are presently in condition for allowance. Should the Examiner be of the view that an interview would expedite consideration of the application, request is made that the Examiner telephone the Applicants' attorney at (703) 433-0510 in order that any outstanding issues be resolved.

If there are any fees due and owing in respect to this amendment, the Examiner is authorized to charge such fees to deposit account number 50-1047.

Serial No. 09/914,279

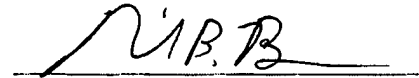
CORRESPONDENCE

Please direct all correspondence to:

Novartis Vaccines and Diagnostics, Inc. (formerly Chiron Corporation)
Intellectual Property Department X-100B
P.O. Box 8097
Emeryville, CA 94662-8097

Attorney for Applicant
Mayer & Williams PC
251 North Avenue West, 2nd Floor
Westfield, NJ 07090
Tel.: 703-433-0510
Fax: 703-433-2362

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'D.B. Bonham', is written over a horizontal line.

David B. Bonham
Registration No. 34,297